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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

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10/072,931

Filing Date

February 12, 2002

First Named Inventor

Shunpei YAMAZAKI et al.

Group Art Unit

2812

Examiner Name

S. Isaac

Attorney Docket Number

0756-2433

ENCLOSURES (check all that apply)☐ Fee Transmittal Form☐ Fee Attached☒ Amendment / Reply☒ After Final☐ Affidavits/declaration(s)☐ Extension of Time Request☐ Express Abandonment Request☐ Information Disclosure Statement☐ Certified Copy of Priority
Document(s)☐ Response to Missing Parts/
Incomplete Application☐ Response to Missing Parts
under 37 CFR 1.52 or 1.53☐ Assignment Papers
(for an Application)☐ Drawing(s)☐ Declaration and Power of
Attorney☐ Licensing-related Papers☐ Petition☐ Petition to Convert to a
Provisional Application☐ Power of Attorney, Revocation
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Remarks

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENTFirm
or
Individual nameEric J. Robinson, Reg. No. 38,285
Robinson Intellectual Property Law Office, P.C.
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21010 Southbank Street
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Signature

Date

August 7, 2006

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August 7, 2006

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Attorney Docket No. 0756-2433

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Shunpei YAMAZAKI et al.

Serial No. 10/072,931

Filed: February 12, 2002

For: METHOD OF MANUFACTURING A
SEMICONDUCTOR DEVICE

) Group Art Unit: 2812

) Examiner: Stanetta D. Isaac

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2006.

Adelle M. Stampfer

RESPONSE

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Official Action mailed May 5, 2006, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on April 5, 2002; October 30, 2002; November 11, 2004; and February 24, 2006.

Claims 1-80 are pending in the present application, of which claims 1, 10, 46-49, 66, 67 and 78 are independent. Claims 1-9, 12, 14, 16, 18, 20, 22, 24, 26, 28, 30, 32, 34, 36, 38, 40, 42, 44, 46, 48, 50, 52, 54, 56, 58, 60, 62, 64, 66, 68, 70, 72, 74 and 76 have been withdrawn from consideration by the Examiner (page 2, Paper No. 0406). Accordingly, claims 10, 11, 13, 15, 17, 19, 21, 23, 25, 27, 29, 31, 33, 35, 37, 39, 41, 43, 45, 47, 49, 51, 53, 55, 57, 59, 61, 63, 65, 67, 69, 71, 73, 75 and 77-85 are currently elected, of which claims 10, 47, 49, 67 and 78 are independent. For the reasons set

forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 10, 13, 15, 17, 25, 27, 29, 33, 35, 37, 39, 41, 47, 49, 51, 53, 55, 57, 63, 65, 67, 69, 71, 73 and 77-80 under the doctrine of obviousness-type double patenting over claims 20-24, 27-31, 33 and 35 of U.S. Patent No. 6,808,968 to Yamazaki. The Applicant respectfully requests that the double patenting rejections be held in abeyance until an indication of allowable subject matter is made in the present application. At such time, the Applicant will respond to any remaining double patenting rejections.

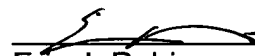
The Official Action rejects claims 10, 11, 13, 15, 17, 19, 21, 25, 27, 29, 31, 33, 35, 37, 39, 41, 43, 45, 47, 49, 53, 55, 57, 59, 61, 63, 65, 67, 71, 73, 75 and 77-85 as obvious based on the combination of U.S. Patent No. 5,789,284 to Yamazaki and U.S. Patent No. 6,821,827 to Nakamura. The Official Action rejects claims 23, 51 and 69 as obvious based on the combination of Yamazaki '284, Nakamura and U.S. Patent No. 6,291,888 to Bhat.

However, Nakamura, as a commonly owned reference under § 102(e), may not be considered for a rejection under § 103. Please note, on October 5, 2005, the Applicant filed a Verified English Translation of the priority document, JP 2001-040837, which was filed February 16, 2001. Nakamura was filed in the U.S. on December 28, 1999, and published on October 25, 2001. As such, Nakamura is only potentially available as prior art under § 102(e). However, subject matter developed by another, which qualifies as prior art only under one or more of subsections 35 U.S.C. §§ 102(e), (f) and (g), is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. § 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made. See MPEP § 2146. Since the disclosure by Nakamura and the claimed invention of the present application were, at the time the invention was made, subject to an obligation of assignment to Semiconductor Energy Laboratory Co., Ltd., Nakamura may not be

considered for a rejection under § 103. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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